

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#15
5-19-01
RP
RECEIVED

MAY 16 2001

TECH CENTER 1600/2900

In re Patent Application of

FODOR et al.

Appln. No. 09/585,659

Filed: June 2, 2000

Group Art Unit: 1655

Examiner: S. Zitomer

FOR: PRODUCTS FOR DETECTING NUCLEIC ACIDS

* * *

May 14, 2001

REPLACEMENT INFORMATION DISCLOSURE STATEMENT

Hon. Commissioner for Patents
Washington, D.C. 20231

Sir:

This information disclosure statement (IDS) is being submitted to replace the three IDS filed June 2, 2000, July 20, 2000, and September 21, 2000. Thus, the Examiner is respectfully requested to use the attached Form PTO-1449 in lieu of those previously submitted. The references that Applicants would like considered in this application are listed on the Form PTO-1449 which is attached.

Contingent IDS Request Under 37 CFR § 1.97(c): Should a first Office Action on the merits have been mailed before today, please consider this a request under Rule 97(c) to consider this IDS in lieu of certification and charge the Rule 17(p) Official fee to our Deposit Account No. 03-3975 under Order No. 71180/254814 for which purpose this paper is submitted in duplicate.

The references cited on the attached Form PTO-1449 are being called to the attention of the Examiner. Copies of the references can be found in a "Master Binder Set" originally submitted to Examiner Tsang on January 27, 2000 and supplemented on dates thereafter. The attached Form PTO-1449 should be used in this application

instead of those previously submitted. The previously submitted Form PTO-1449 can be lined through by the Examiner because the attached includes all of the references listed therein.

Applicants are mindful of the large number of references that have been cited in the IDS and attached Form PTO-1449. However, these references have arisen during multiple litigations and oppositions involving patents that relate to the present application as well as the normal course of prosecution. Applicants have cited them to fulfill their duty of disclosure. In an effort to make the review of these references more manageable on the Examiner, Applicants have provided the PTO with multiple copies of two compact discs (CDs) on which the references are available for electronically viewing or searching. Previous versions of this IDS and CD set have been submitted to the PTO for references that were available at the time that the CDs were created. The current IDS incorporates additional references that have recently been disclosed in more recent litigation and a new version of the CDs (Version 3) has been prepared and sent to the PTO as discussed below.

Applicants representative, Mr. Philip McGarrigle, has provided the revised CDs to Supervisory Primary Examiners Michael Woodward and Gary Jones, and Special Examiner Cecilia Tsang. Previous versions were also given to these supervisors and Group Director John Doll. The CDs given to Messrs. Woodward and Jones were for distribution to individual Examiners within their respective groups as they saw fit. The CDs presented to Examiner Tsang were to accompany the hard copies of the references in the IDS, which are in a central location in her office for the availability of all Examiners.

Of the two CDs that make up the IDS, one contains the articles and another contains patents/published applications. The CD containing the articles is in .pdf

format and can be viewed by selecting the appropriate article as discussed below. The patent CD contains text versions and versions of the patents with the appropriate figures. It is fully searchable and contains a program that has the ability to search for specific terms or to use Boolean logic to formulate more specific searches. There are links within each full text patent to the patents that are cited therein.

The vendor who prepared the patent literature CD suggests that you open the README.HTML file in the root directory of the CD before use. It contains the directions on how to use the CD, as well as a hyperlink to the patent list. The CD that contains the articles suggests that you open "Index" or "Index2" to view images. You will see Form PTO-1449 which list the articles which can be opened by clicking on the hyperlinked number of the article in the left hand column.

The references submitted on July 20, 2000, and September 21, 2000, which are listed on page 1 of the Form PTO-1449 filed therewith, were only provided as paper copies and not in electronic form.

Additionally, Applicants would like to notify the Examiner of inter parte matters that relate to the present application. Two commonly owned patents US 5,744,305 and US 5,800,992 have been involved in interference proceedings. Specifically, the interferences were Interference No. 104,359 between commonly owned US 5,744,305 and Brown et al., USSN 08/688,488, and Interference No. 104,358 between commonly owned US 5,800,992 and USSN 08/514,875. Both interferences have been decided (subject to current appeal in District Court of Northern California, Civil Case No. C99 21111-JF/EAI) by the USPTO in favor of real party in interest Affymetrix, the assignee of the present application. The Junior party challenged the patents on the basis of lack of enablement and written description under 35 USC §112, among other issues. The Junior party's initial position is set out in papers (with

supporting information) entitled “Request for Declaration of Interference, 37 C.F.R. §1.608” in both interferences. The initial response of Senior party Patentee is set out in papers (with supporting information) entitled “Fodor’s Opposition to Brown’s Rule 608(b) Request” in both interferences.

Further, US 5,744,305 and US 5,800,992 are the subject of litigation (*Affymetrix, Inc. v. Hyseq, Inc.*, US District Court for the Northern District of California, San Francisco Division, Civil Action No. C98-03192 FMS, and *Affymetrix. v. Synteni, Inc. and Incyte Pharmaceuticals, Inc.*, US District Court for the Northern District of California, San Francisco, Case No. C98-4508 FMS (MEJ)). In the course of these proceedings, allegations of invalidity over prior art, lack of enablement, lack of support and inequitable conduct (relating to duty of candor, content of declarations under 37 CFR § 1.132, and arguments made during prosecution) have been raised. These allegations are denied. In a more recent lawsuit with Incyte Genomics (*Incyte Genomics Inc. v. Affymetrix*, U.S. District Court, Northern district of California, San Francisco division and is Case No. C 00-3210 JF.), Affymetrix counterclaimed for patent infringement under US 5,871,928 ('928) and US 6,040,193. The '928 patent is in a related family to the present application. Incyte has filed their “Initial Disclosure of Prior Art” and the references cited therein have been included into the current IDS.

Further, oppositions have been filed against a related European application EP 619,321 in the European Patent Office, and a revocation proceeding has been brought in the United Kingdom against related patents GB 2,248,840 and EP (UK) 0619 321. Collectively, these proceedings have generated a considerable number of references, which were cited on the information disclosure statement and CDs filed above. Applicants can provide copies of litigation documents that may be of interest

to the Examiner, but have not done so due to the extensive nature of the multiple litigation and papers filed therein.


This Information Disclosure Statement (IDS) is intended to be in full compliance with the rules, but should the Examiner find any part of its required content to have been omitted, prompt notice to that effect is earnestly solicited, along with additional time under 37 CFR § 1.97(f), to enable Applicants to comply fully.

As provided for by 37 CFR § 1.97(g) and (h), no inference should be made that the information and references cited are prior art merely because they are in this statement and no representation is being made that a search has been conducted or that this statement encompasses all the possible relevant information.

Consideration of the foregoing and enclosures, as well as the return of a copy of the attached Form PTO-1449 with the Examiner's initials per M.P.E.P. § 609, are earnestly solicited. The Examiner is invited to contact the undersigned if further information is needed.

Respectfully submitted,

Intellectual Property Group of
PILLSBURY WINTHROP, L.L.P.

By  43,180
for Paul N. Kokulis
Reg. No. 16,773

PNK/GRT:nlh
1100 New York Avenue, N.W.
Ninth Floor – East Tower
Washington, D.C. 20005-3918
Tel: (202) 861-3503
Fax: (202) 822-0944

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

FODOR et al.

Appln. No. 09/585,659

Filed: June 2, 2000

FOR: PRODUCTS FOR DETECTING NUCLEIC ACIDS



Group Art Unit: 1655

Examiner: S. Zitomer

* * *

May 14, 2001

REPLACEMENT INFORMATION DISCLOSURE STATEMENT

Hon. Commissioner for Patents
Washington, D.C. 20231

Sir:

This information disclosure statement (IDS) is being submitted to replace the three IDS filed June 2, 2000, July 20, 2000, and September 21, 2000. Thus, the Examiner is respectfully requested to use the attached Form PTO-1449 in lieu of those previously submitted. The references that Applicants would like considered in this application are listed on the Form PTO-1449 which is attached.

Contingent IDS Request Under 37 CFR § 1.97(c): Should a first Office Action on the merits have been mailed before today, please consider this a request under Rule 97(c) to consider this IDS in lieu of certification and charge the Rule 17(p) Official fee to our Deposit Account No. 03-3975 under Order No. 71180/254814 for which purpose this paper is submitted in duplicate.

The references cited on the attached Form PTO-1449 are being called to the attention of the Examiner. Copies of the references can be found in a "Master Binder Set" originally submitted to Examiner Tsang on January 27, 2000 and supplemented on dates thereafter. The attached Form PTO-1449 should be used in this application

instead of those previously submitted. The previously submitted Form PTO-1449 can be lined through by the Examiner because the attached includes all of the references listed therein.

Applicants are mindful of the large number of references that have been cited in the IDS and attached Form PTO-1449. However, these references have arisen during multiple litigations and oppositions involving patents that relate to the present application as well as the normal course of prosecution. Applicants have cited them to fulfill their duty of disclosure. In an effort to make the review of these references more manageable on the Examiner, Applicants have provided the PTO with multiple copies of two compact discs (CDs) on which the references are available for electronically viewing or searching. Previous versions of this IDS and CD set have been submitted to the PTO for references that were available at the time that the CDs were created. The current IDS incorporates additional references that have recently been disclosed in more recent litigation and a new version of the CDs (Version 3) has been prepared and sent to the PTO as discussed below.

Applicants representative, Mr. Philip McGarrigle, has provided the revised CDs to Supervisory Primary Examiners Michael Woodward and Gary Jones, and Special Examiner Cecilia Tsang. Previous versions were also given to these supervisors and Group Director John Doll. The CDs given to Messrs. Woodward and Jones were for distribution to individual Examiners within their respective groups as they saw fit. The CDs presented to Examiner Tsang were to accompany the hard copies of the references in the IDS, which are in a central location in her office for the availability of all Examiners.

Of the two CDs that make up the IDS, one contains the articles and another contains patents/published applications. The CD containing the articles is in .pdf

format and can be viewed by selecting the appropriate article as discussed below. The patent CD contains text versions and versions of the patents with the appropriate figures. It is fully searchable and contains a program that has the ability to search for specific terms or to use Boolean logic to formulate more specific searches. There are links within each full text patent to the patents that are cited therein.

The vendor who prepared the patent literature CD suggests that you open the README.HTML file in the root directory of the CD before use. It contains the directions on how to use the CD, as well as a hyperlink to the patent list. The CD that contains the articles suggests that you open "Index" or "Index2" to view images. You will see Form PTO-1449 which list the articles which can be opened by clicking on the hyperlinked number of the article in the left hand column.

The references submitted on July 20, 2000, and September 21, 2000, which are listed on page 1 of the Form PTO-1449 filed therewith, were only provided as paper copies and not in electronic form.

Additionally, Applicants would like to notify the Examiner of inter parte matters that relate to the present application. Two commonly owned patents US 5,744,305 and US 5,800,992 have been involved in interference proceedings. Specifically, the interferences were Interference No. 104,359 between commonly owned US 5,744,305 and Brown et al., USSN 08/688,488, and Interference No. 104,358 between commonly owned US 5,800,992 and USSN 08/514,875. Both interferences have been decided (subject to current appeal in District Court of Northern California, Civil Case No. C99 21111-JF/EAI) by the USPTO in favor of real party in interest Affymetrix, the assignee of the present application. The Junior party challenged the patents on the basis of lack of enablement and written description under 35 USC §112, among other issues. The Junior party's initial position is set out in papers (with

supporting information) entitled “Request for Declaration of Interference, 37 C.F.R. §1.608” in both interferences. The initial response of Senior party Patentee is set out in papers (with supporting information) entitled “Fodor’s Opposition to Brown’s Rule 608(b) Request” in both interferences.

Further, US 5,744,305 and US 5,800,992 are the subject of litigation (*Affymetrix, Inc. v. Hyseq, Inc.*, US District Court for the Northern District of California, San Francisco Division, Civil Action No. C98-03192 FMS, and *Affymetrix, Inc. v. Synteni, Inc. and Incyte Pharmaceuticals, Inc.*, US District Court for the Northern District of California, San Francisco, Case No. C98-4508 FMS (MEJ)). In the course of these proceedings, allegations of invalidity over prior art, lack of enablement, lack of support and inequitable conduct (relating to duty of candor, content of declarations under 37 CFR § 1.132, and arguments made during prosecution) have been raised. These allegations are denied. In a more recent lawsuit with Incyte Genomics (*Incyte Genomics Inc. v. Affymetrix*, U.S. District Court, Northern district of California, San Francisco division and is Case No. C 00-3210 JF.), Affymetrix counterclaimed for patent infringement under US 5,871,928 ('928) and US 6,040,193. The '928 patent is in a related family to the present application. Incyte has filed their “Initial Disclosure of Prior Art” and the references cited therein have been included into the current IDS.

Further, oppositions have been filed against a related European application EP 619,321 in the European Patent Office, and a revocation proceeding has been brought in the United Kingdom against related patents GB 2,248,840 and EP (UK) 0619 321. Collectively, these proceedings have generated a considerable number of references, which were cited on the information disclosure statement and CDs filed above. Applicants can provide copies of litigation documents that may be of interest

to the Examiner, but have not done so due to the extensive nature of the multiple litigation and papers filed therein.


This Information Disclosure Statement (IDS) is intended to be in full compliance with the rules, but should the Examiner find any part of its required content to have been omitted, prompt notice to that effect is earnestly solicited, along with additional time under 37 CFR § 1.97(f), to enable Applicants to comply fully.

As provided for by 37 CFR § 1.97(g) and (h), no inference should be made that the information and references cited are prior art merely because they are in this statement and no representation is being made that a search has been conducted or that this statement encompasses all the possible relevant information.

Consideration of the foregoing and enclosures, as well as the return of a copy of the attached Form PTO-1449 with the Examiner's initials per M.P.E.P. § 609, are earnestly solicited. The Examiner is invited to contact the undersigned if further information is needed.

Respectfully submitted,

Intellectual Property Group of
PILLSBURY WINTHROP, L.L.P.

By  43,180
for Paul N. Kokulis
Reg. No. 16,773

PNK/GRT:nlh
1100 New York Avenue, N.W.
Ninth Floor – East Tower
Washington, D.C. 20005-3918
Tel: (202) 861-3503
Fax: (202) 822-0944